

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP**
Stephanie Ayala et al.)
Application No.: 09/545,288) Group Art Unit: 3729
Filed: April 7, 2000) Examiner: MINH N. TRINH
For: METHOD FOR MAKING SMART) Confirmation No.: 1602
CARDS CAPABLE OF OPERATING)
WITH AND WITHOUT CONTACT)

PETITION UNDER 37 C.F.R. § 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully Petition the Director under 37 C.F.R. § 1.144 to rejoin Claims 47-53 for examination.

As background, in the May 13, 2008 response after a Non-Final Office Action, Applicants, *inter alia*, added new Claims 47-51. The Examiner then issued a Final Office Action on August 21, 2008 which did not address Claims 47-51.

Applicants then filed a Request for Reconsideration on January 21, 2009, in which Applicants, *inter alia*, requested that the finality of the August 21, 2008 Office Action be withdrawn and that Claims 47-51 be addressed. The Examiner did not withdraw the finality of the Office Action or issue a replacement Office Action. Instead, the Examiner issued an Advisory Action on February 19, 2009 which stated, *inter alia*, that "claims 47-51 should be restricted" and that "the scope of the original claims are not the same as the new claims (see preamble)."

Applicants then filed an Amendment with a Request for Continued Examination on February 23, 2009, in which Applicants, *inter alia*, requested rejoinder of Claims 47-51 and added new Claims 52 and 53. In requesting rejoinder of Claims 47-51, Applicants noted that the Examiner's basis for requiring restriction failed to conform with the requirements set forth

in Chapter 800 of the Manual of Patent Examining Procedure. The Examiner then issued a Non-Final Office Action on August 4, 2009 which did not address Claims 52 and 53 or Applicants' request for rejoinder of Claims 47-51.

Applicants then filed an Amendment on November 4, 2009 in which Applicants, *inter alia*, added Claims 54-56 and requested that the Examiner address Claims 52 and 53. In response, the Examiner issued a Final Office Action on March 11, 2010. The March 11, 2010 Final Office Action did not address the status of Claims 54-56¹ and indicated that Claims 52 and 53 were now withdrawn from consideration for the same reasons as Claims 47-51. The Final Office Action additionally stated that "the subject matters of as recited in claims 47-53 are not recited in the originally rejected claims and the Office generally does not permit shift of elected subject matter (see section 819 of the MPEP)."

Applicants now respectfully Petition the Director under 37 C.F.R. § 1.144 to rejoin Claims 47-53 for examination because the Examiner's basis for requiring restriction failed to conform with the requirements set forth in Chapter 800 of the Manual of Patent Examining Procedure. Specifically, In the February 19, 2009 Advisory Action and the March 11, 2010 Final Office Action, the Examiner simply pointed out that the new claims are of different scope and recite different subject matter than the pending claims. Applicants respectfully submit that the Examiner has applied the incorrect inquiry. Indeed, different claims are required to have different scope and recite different subject matter. As discussed in Section 808.01 of the Manual of Patent Examining Procedure, a proper restriction requirement must explain why the inventions are independent or distinct, for example, why claimed subcombinations have utility by themselves or in other combinations, or why a claimed combination does not require the particulars of a claimed subcombination. Here, the Examiner has not set forth any such analysis. The basis for requiring restriction is therefore clearly improper.

Based on the above, it is respectfully is respectfully requested that the improper restriction requirement be withdrawn and Claims 47-53 be rejoined and examined.

No fees are believed due with this paper. However, the Director is hereby authorized to charge any appropriate fees that may be required by this paper to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: May 25, 2010

By: /Peter T. deVore/
Peter T. deVore
Registration No. 60361

Customer No. 21839
703 836 6620

¹ The Finality of the March 11, 2010 Office Action is clearly improper in view of its failure to address the status of Claims 54-56. A Petition requesting withdrawal of the Finality of the March 11, 2010 Office Action is being filed concurrently with this Petition.